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**OFFICE OF PETITIONS
A/C PATENTS**

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1299 PENNSYLVANIA AVE., N.W.
WASHINGTON, D.C. 20004-2400

In re Application of: :
Moskowitz et al. :
Application No. 09/456,319 : DECISION REFUSING STATUS
Filed: December 8, 1999 : UNDER 37 CFR 1.47(a)
Att'ney Dckt No. 066603.0122 :
For: Z-TRANSFORM
IMPLEMENTATION OF DIGITAL
WATERMARKS

This is a decision on the petition filed March 17, 2000, under 37 CFR 1.47(a) requesting that this application be accorded status.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO RESPOND WILL RESULT IN THE ABANDONMENT OF THIS APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

A grantable petition under 37 CFR 1.47(a) requires (1) a petition including proof of the pertinent facts establishing the joint inventor(s) refuses to sign the oath or declaration, or cannot be found or reached after diligent effort; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) proof of irreparable damage. This petition lacks item (1) set forth above.

This application was filed on December 08, 1999, and in reply to the Notice of Missing Parts of March 17, 1999, applicants filed *inter alia*, the instant petition, and a declaration lacking the signature of joint inventor Marc Cooperman.

However, the showing of record only reveals that the only effort to locate or reach Mr. Cooperman to present him with a copy of 1) Assignment of application to Wistaria Trading, Inc; 2) Small Entity Statement as an independent inventor; and 3) Declaration supporting Inventorship (see Exhibit A), was to mail the papers to Cooperman at the last known address as stated in the petition.

The above application and papers have been reviewed but have not been found in compliance with 37 CFR 1.47(a) based upon the following reasons:

(1) Applicants have failed to show or provide adequate proof that a diligent effort was made to reach or locate Cooperman. However, the applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the non-signing inventor. See MPEP 409.03(a).

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventor. The statement(s) of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay, will not normally be accepted. At the very least, a search should be made of the telephone directories of the Maplewood, New Jersey area where allegedly Mr. Cooperman filed a complaint in the United States District Court for the Southern District of Florida. What does inspection of the phone directories for those address locations reveal? Copies of the results of the search must be referred to in any renewed petition. See MPEP 409.03(d). If Mr. Cooperman is located, then a copy of the transmittal letter itemizing the complete application papers, as well as a copy of the proof of service on Mr. Cooperman will be required. Petitioner is advised that if the search reveals that Mr. Cooperman is now deceased, then his legal representatives or heirs will have to be proffered the complete application papers for signature. See also MPEP 409.01(a), (b); MPEP 409.03(c).

It is important that the forthcoming communication contain statements of fact as opposed to conclusions. If there is

an express oral refusal, a statement from the person to whom that refusal was made should be made of record.

(2) The petition also failed to provide a proof that the letter dated December 29, 1999 from Mr. Chapman to Mr. Cooperman's last known address was returned as undeliverable. A copy of the Federal Express records is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza 4, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Kien Nguyen at (703) 306-5592 or in his absence, the undersigned at (703) 305-1820.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects